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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204186
Party	Plaintiff ZippMark, Inc.
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Date	12/10/2012
Attachments	121210 ZippMark's Answer to Blec's Counterclaim.pdf (5 pages)(31422 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos. 85/131965, 85/131287, and 85/092,665
Published in the Official Gazettes of November 8 and November 29, 2011
Marks: **BLU and Design, BLU, and BLU CIGS**

ZIPPMARK, INC.,

Opposer,

v.

BLEC, LLC,

Applicant.

Opposition No.: 91204186

ZIPPMARK, INC.'S ANSWER TO BLEC, LLC'S COUNTERCLAIM

ZippMark, Inc. ("ZippMark") hereby answers Blec, LLC's ("Blec") Counterclaims. The paragraphs and headings below correspond to the paragraphs and headings of Blec's Counterclaim.

COUNTERCLAIM 1

1. ZippMark admits that on September 17, 2010, Blec filed application Serial No. 85/131,965 seeking to register BLU & Design in Class 34 for "Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco substitutes." Zippmark admits that the image in paragraph 1.a is the design mark that Blec seeks to register by application Serial No. 85/131,965. Zippmark further admits that on September 16, 2010, Blec filed application Serial No. 85/131,287, seeking to register BLU in Class 34 for "Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes; Electronic

cigarettes for use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco substitutes.” Zippmark admits that on July 26, 2010, Blec filed application Serial No. 85/092,665, seeking to register BLU CIGS in Class 34 for “Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco substitutes.” Zippmark lacks sufficient knowledge to admit or deny the remaining allegations of this paragraph, and denies them on that basis.

2. ZippMark admits the allegations of this paragraph.

3. ZippMark admits the allegations of this paragraph.

4. ZippMark admits the allegations of this paragraph.

5. ZippMark admits the allegations of this paragraph.

6. ZippMark admits the allegations of this paragraph.

7. ZippMark admits the allegations of this paragraph.

8. Zippmark denies that the goods described in the applications for Blec’s marks “are significantly different from the goods covered by the registrations for Opposer’s Marks.”

Zippmark admits the remaining allegations of this paragraph.

9. ZippMark admits the allegations of this paragraph.

10. Zippmark admits the allegations of this paragraph.

11. Zippmark admits that each of Opposer’s Marks (as that term is defined in the Counterclaim) contains “blu” in some form. Zippmark denies the remaining allegations of this paragraph.

12. Exhibits 1 through 5 speak for themselves; Blec’s attempted characterization of the exhibits constitutes improper argument and not factual allegations. Even assuming that

Blec's attempted characterization of the exhibits were deemed factual allegations, Zippmark denies them. Zippmark admits that its BLU lighter products produce a blue flame and that the color blue is, at times, used in its advertising. Zippmark denies the remaining allegations of this paragraph.

13. Zippmark denies the allegations of this paragraph.

14. Zippmark denies the allegations of this paragraph.

15. Zippmark denies the allegations of this paragraph.

16. Zippmark denies the allegations of this paragraph.

ZIPPMARK'S DEFENSES

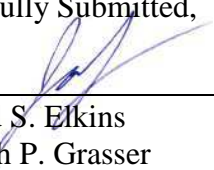
1. Blec's counterclaims are barred under the doctrines of laches, waiver and acquiescence.

2. Blec's counterclaims and its requested relief are barred under the doctrine of unclean hands because Blec has engaged in the same conduct of which it now complains.

Date: December 10, 2012

Respectfully Submitted,

By



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PROOF OF SERVICE
(Pursuant to Federal Law)

The undersigned certifies and declares as follows:

I am a resident of the State of California and over 18 years of age and am not a party to this action. My business address is 600 Hansen Way, Palo Alto, California 94304, which is located in the county where any non-personal service described below took place.

On December 10, 2012, a copy of the following document(s):

ZIPPMARK, INC.'S ANSWER TO BLEC, LLC'S COUNTERCLAIM

was served on:

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Service was accomplished as follows.

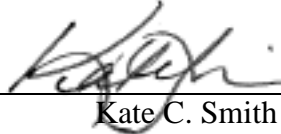
☒ **By U.S. Mail.** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice the mail would be deposited with U.S. postal service on that same day with postage thereon fully prepaid at San Francisco, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

☐ **By Facsimile.** On the above date, I transmitted the above-mentioned document(s) by facsimile transmission machine to the parties noted above, whose facsimile transmission machine telephone number is set forth above.

☐ **By Express Service Carrier.** On the above date, I sealed the above document(s) in an envelope or package designated by Federal Express, an express service carrier, addressed to the above, and I deposited that sealed envelope or package in a box or other facility regularly maintained by the express service carrier, or delivered that envelope to an authorized courier or driver authorized by the express service carrier to receive documents, located in San Francisco, California with delivery fees paid or otherwise provided for.

☒ **By E-mail.** by transmitting via e-mail or electronic transmission the document(s) listed above to the person(s) at the e-mail address(es) set forth below.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made. Executed on December 10, 2012, at San Francisco, California.



Kate C. Smith